

A recent CAFC decision¹ concerns patents related to the present application and is attached as Exhibit A. In this decision, the CAFC limits the claimed inflatable thermal blankets to thermal blankets which are self-erecting. In response, the applicant removes “inflatable thermal blanket” language from the present claims and instead specifies an “an inflatable cover for controlling the temperature of a person” (claims 20-34) and an “inflatable cover” (claims 35-39). This amendment is intended to ensure that the covers claimed in the present application are not limited to self erecting inflatable thermal blankets.

Rejection Under 35 USC §102 (b)

The Examiner rejects claims 20, 21, 22, 34 and 35 as being anticipated by EP 0113420 A1 (Roehr). The claimed invention relates to an inflatable cover having an upper sheet attached to the upper surface of a base sheet to form an inflatable structure. A plurality of apertures in the base sheet allow an inflation medium to be exhausted from within the inflatable structure. Roehr teaches a cover for individuals to be supplied either with warm air or with cold air.

In response to the Examiner’s rejection, the applicant re-asserts the arguments on record and adds the following new argument with respect to claim 35. Independent claim 35 specifies “a non-inflatable portion defining a recess near a first end of the inflatable structure”. Roehr does to teach or suggest a non-inflatable portion defining a recess near a first end of the inflatable structure as specified in claim 35. Since Roehr does not teach each element of independent claim 35, Roehr does not anticipate independent claim 35 and the rejection under 35 USC §102 (b) should be withdrawn.

Rejection Under 35 USC §103

The Examiner rejects independent claim 35 as being obvious over EP 0113420 A1 (Roehr) in view of United State Patent Number 3,714,947 (Hardy). As described above, Roehr teaches a cover for individuals to be supplied either with warm air or with cold air. Hardy teaches an infant bunting. The bunting includes snap fasteners for adjusting the longitudinal size of the bunting to conform to different infant body sizes.

¹ Augustine v. Gaymar 50 USPQ2d 1900 50 USPQ2d 1900 (CAFC 1999).

In response to the examiner's rejection, the applicant re-asserts the arguments on record and adds the following new arguments.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

With respect to the first requirement, no motive exists to combine the cited prior art sources. There is no suggestion to modify Roehr's cover with the bunting disclosed by Hardy. Further, there is no suggestion in either Roehr or Hardy that a warming cover could be modified with bunting technology to achieve an improved product. As a result, there is no motivation for an inventor working on warming covers to look toward developments in bunting technology. Hence, there is no motive to combine the cited references.

"Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." *In re Dembiczak*, 175 F.3d 994, 999, U.S.P.Q.2d 1614. The Applicant respectfully submits that the cited prior art is only modified in retrospect, in light of the present invention. That is, the obviousness rejection is based upon the Applicant's own invention characterization, not the modification of Roehr with Hardy. Despite the Examiner's argument that one skilled in the art would have been motivated to modify the cover of Roehr with the bunting of Hardy, Applicant can find no suggestion in the drawings and English Abstracts of either source to suggest any such modifications.

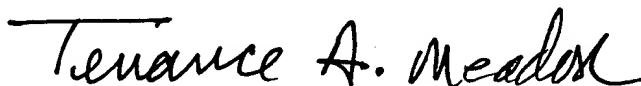
With respect to the second point, there is no reasonable expectation of success in combining these references. Hardy teaches a plurality of tubes attached to a panel. A temperature controlled fluid is circulated through these tubes. See column 3, lines 6-10, column 3, lines 33-35 and column 3, lines 65-column 4, line 1. In contrast, Roehr teaches a "cover consisting of two layers whose borders are welded together, is provided with a multiple of inter-

connected air duct like sectors by means of welded or glued sections to guide the air to air exit openings." See Abstract. There is no suggestion how the teachings of Roehr are to be combined with the very different teachings of Hardy. Without some suggestion how these technologies should be combined, the cited references do not provide a reasonable expectation of success as required in the second prong of the obviousness requirements.

The combination of cited prior art references also fails the third of the above-mentioned obviousness requirements as shown in the arguments of record. These arguments are re-asserted here.

It is believed that this application is now in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,



Date: 25 January 2000

TERRANCE A. MEADOR
Registration No. 30,298

GRAY CARY WARE & FREIDENRICH
401 B Street, Suite 1700
San Diego, California 92101

Telephone: (619) 699-2652 Fax: (619) 236-1048